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OFFICE OF PETITIONS

In re Application of	:	
STEPHEN F. GASS	:	
Application No. 09/676,190	:	DECISION ON APPLICATION
Filed: September 29, 2000	:	FOR
Atty Docket No. SDT 316	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "Application for Patent Term Adjustment under 37 CFR 1.704(b)" filed January 18, 2006 requesting that the Office reconsider the determination of Patent Term Adjustment (PTA) that accompanied the Notice of Allowance. Applicant requests that the initial determination of the patent term adjustment in this application be corrected from zero (0) days to seventy-nine (79) days.

The request for patent term adjustment is **DISMISSED.**

For the reasons stated herein, the Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **zero (0)** days, including **312** days of applicant delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

Background

On October 18, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was zero (0) days.

In response, applicant timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 CFR 1.18(e). Applicant requests that the patent term adjustment be corrected to 79 days. The basis for this correction is 37 CFR 1.702(a)(1). Applicant contends that the patent term should be adjusted because the first notification under 35 U.S.C. 132 received by the applicant in the form of a restriction requirement mailed on August 23, 2002 addressed the wrong claims because it did not take into account the preliminary amendment filed on March 2, 2001 which canceled claims 1-20 and submitted new claims 21-34. Upon notification of the error in applicant's response filed on September 16, 2002, a second restriction requirement action was mailed to applicant on December 3, 2002.

Applicant contends that since the restriction requirement mailed on August 23, 2002 was in error, the first notification under 35 U.S.C. 132 to applicant should start with the second mailing of the restriction requirement on December 3, 2002 which would result in a corrected PTO delay over 14 months of 372 days instead of 267 days.

Applicant further states that since the first restriction requirement of August 23, 2002 is not a proper first notification, then the 2 day delay charged to applicant for the filing of the Information Disclosure Statement on August 18, 2002 should also be reconsidered.

Applicant also states that the patent issuing from the application is not subject to a terminal disclaimer

Relevant statues and regulations

35 U.S.C. 132(a) provides that:

> Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

35 U.S.C. 154(b)(1)(A)(i) provides that

> - Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to-
> (i) provide at least one of the notifications under section 132 of this title or a notice of allowance under section 151 of this title not later than 14 months after the date on which an application was filed under section 111(a) of this title; or the date on which an international application fulfilled the requirements of section 371 of this title;

37 CFR § 1.702(a) provides that:

> Failure to take certain actions within specified time frames. Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to: (1) Mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 in an international application;

37 CFR § 1.703(a) provides that:

> The period of adjustment under § 1.702(a) is the sum of the following periods: (1) The number of days, if any, in the period beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a) or fulfilled the requirements of 35 U.S.C. 371 and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

37 CFR § 1.704(b) provides that:

> With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or

other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

37 CFR § 1.704(c)(8) provides that:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

37 CFR § 1.704(d) provides that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

OPINION

Applicant's arguments and evidence have been considered, and in light of the application history, it has been determined that the initial period of adjustment pursuant to 1.702(a)(1) is

correct. The Office *did* mail a notification under 35 U.S.C. 132 within the meaning of 1.702(a)(1) on August 23, 2002.

Accordingly, the period of adjustment for PTO delay over 14 months was properly calculated as 267 days counting the number of days beginning on November 29, 2001, the day after the date that is fourteen months after the date on which the application was filed, to August 23, 2002, the date of mailing of the first restriction requirement.

Applicant argues that the first restriction requirement mailed on August 23, 2002 cannot be considered to be the first notification because it does not meet the requirements of 35 U.S.C. 132 because it did not reject claims or make any legitimate objection or requirement as required by statute. This argument is not persuasive because 35 U.S.C. 132 only requires notification to the applicant of any rejection, objection, or requirement along with the reasons for such and including information and references as to be useful in judging the propriety of continuing prosecution of the application. Further, the statue under U.S.C. 154(b) does not pertain to the correctness or the legitimacy of the requirement or objection being made under 35 U.S.C. 132.

Pursuant to 35 U.S.C. 154(b)(1)(A), applicant is only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first 14 months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until August 23, 2002. The Office did make such a notification under U.S.C. 132 to which applicant responded on September 16, 2002. The fact that a second restriction requirement was mailed does not alter the fact that the Office did mail an action under 35 U.S.C. 132 to the applicant on August 23, 2002. Accordingly, in this case, it is correct for the Office to use the date of August 23, 2002 in calculating the period of adjustment due to the examination delay in initially acting on this application. See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term;* Final Rule, 65 Fed. Reg. 543366 (September 18, 2000).

Thus, it is concluded that, the delay pursuant to §1.702(a)(1) is properly calculated based on the mailing of a first restriction requirement office action under 35 U.S.C. 132, and the second restriction requirement office action under 35 U.S.C. 132 mailed on December 3, 2002 was in response to and within four months of applicant's response filed on September 16, 2002,

and thus, did not constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

In light thereof, the reduction of the two (2) days associated with the IDS filed on September 18, 2002 is correct.

A review of the record reveals that the period of adjustment for applicant delay was not properly calculated. Applicant should have been assessed a delay of seventeen (17) days in addition to the 295 days initially shown on the Patent Term Adjustment Calculations for a total of 312 days due to applicant delay.

A supplemental electronic IDS was filed on April 17, 2004, 17 days after the filing of the response to a non-final action by applicant dated March 31, 2004. An IDS filed after a response is considered to be a supplemental reply pursuant to 1.704(c)(8) unless it contains the statement pursuant to 1.704(d). The electronic IDS dated April 17, 2004 does not contain the required statement under 1.704(d), and thus is considered to be a supplemental response under 1.704(c)(8) as a failure to engage in reasonable efforts to conclude prosecution. Therefore, an additional delay of 17 days is added to applicant's delay.

The filing of another supplemental electronic IDS on July 24, 2005 and a supplemental response on August 15, 2005, after the filing of a response to the non-final by applicant dated June 15, 2005 caused an additional 39 days and 61 days, respectively, to applicant's delay. Since these periods overlapped with applicant's delay of 112 days from the filing of the IDS on October 5, 2005 shown on the initial patent term adjustment calculations, there would be no additional adjustment from these communications.

Conclusion

In view thereof, adjustments to the initial patent term calculations for USPTO delay as requested by applicant is not warranted and the petition is dismissed.

The USPTO delay is correct at 270 days and applicant delay has been adjusted to 312 days for a patent term adjustment of zero (0) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment shown on the patent (and in the Issue Notification mailed approximately three weeks prior to issuance) will include any additional patent term accrued pursuant to sections 1.702(a)(4) and 1.703(b).

Telephone inquiries specific to this matter should be directed to Amelia Au at 571.272.7414.

Nancy Johnson
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Office of Petitions

Enclosure: Copy of Revised PAIR Screen